

Remarks

Claims 1, 19, 26, 29, 31-33, and 42-45 were rejected under 35 U.S.C. §102(b) as being anticipated by the Corcuff et al. “In vivo Vision of the Human Skin with the Tandem Scanning Microscope,” *Dermatology* 1993, No. 186, pp. 50-54 (“Corcuff article”). It is the Examiner’s position that the “surface contact device” mentioned in the Corcuff article is a plate. Merely because a device contacts a surface does not infer that it is a plate or that it inherently applies force to stress tissue. There are many ways a device can contact a surface, which does not imply that such device has a plate that is imaged through.

Nevertheless, Claims 1 and 26 have been amended to describe the imaging head as having at least an objective lens for focusing the light under the surface of skin tissue and collecting the returned light through a plate, and at least one actuator capable of moving the objective lens to change location of the focusing in the tissue. Also, Claim 43 has been amended to describe the imaging means as having comprises optics in which the maintaining means limits view of tissue by such optics and the optics are movable to focus and collect light from different locations of the tissue in the limited view provided by the maintaining means. These amendments are not new matter as they are supported by incorporated by reference U.S. Patent Application No. 08/650,684, now U.S. Patent No. 5,788,639, see specification of the present application at page 5, lines 23-25, page 8, lines 23-24, and page 10, lines 16-18. As the Corcuff Article does not describe such imaging head or imaging means, withdrawal of the anticipation rejection of Claims 1, 26, and 43, and of their respective dependent Claims 19, 29, 31-33, 42, and 44-45, is requested.

Claims 1, 2, 6, 8, 19, 26-36, and 42-48 were rejected under 35 U.S.C. §103(a) as being unpatentable over the Corcuff Article in view U.S. Patent No. 5,146,923 (Dhawan). The Corcuff Article does not describe or even suggest the imaging head of amended Claims 1, 26, and 47, the imaging means of Claim 43, the positioning step of Claim 35, and Dhawan’s nevoscope does not suggest such elements or step missing in the Corcuff Article. Thus, Claims 1, 2, 6, 8, 19, 26-36, and 42-48 are patentable over the combination of the Corcuff Article and Dhawan.

Claim 3 was rejected under 35 U.S.C. §103(a) as being unpatentable over the Corcuff article in view of Dhawan, and further in view of the Jester et al. article “In Vivo, Real-time Control Imaging” in the *Journal of Electron Microscopy Techniques*, Vol. 18, No. 1 (1991). Claim 3 depends on Claim 1, which for reasons argued earlier is patentable over the Corcuff

article and Dhawan. As Jester et. al. also fails to describe the imaging head of Claim 1, withdrawal of the rejection of its dependent Claim 3 is requested.

Claims 20 and 23 were rejected under 35 U.S.C. §103(a) as being unpatentable over the Corcuff article in view of Dhawan, and further in view of Jester et al. Based on arguments set forth in the Amendment filed April 19, 2005 over this rejection, these claims are patentable. Nevertheless, Claim 20 has been amended to clarify the invention by describing that when the platen is in its down position the orifice of the platen provides an open unsealed space over skin tissue. This is not new matter as evident from orifice 32 of FIG. 4 showing in more detail the platen of FIGS. 1-3 of the present application, in which the orifice is clearly an open unsealed space. This is in contrast with Dhawan in which the Examiner stated on page 3 at lines 6-8, and page 4 at lines 16-18, of the Office Action of June 30, 2005 that Dhawan's "means for maintaining the tissue under stress includes a platen 54 and suction means which applies a force against at least the edges of the area of skin tissue being imaged". Although Applicant disputes that Dhawan describes the claimed platen, it is clear that it relies on suction to its cup-shaped housing 44, in which the "specimen housing 44 and the optical waveguide 54 is coated with a gasket material 49 to improve the seal between the specimen housing 44 and the skin lesion when suction is applied on the specimen." (quoting Dhawan at column 8, lines 9-13). Since Dhawan relies in its sealed specimen housing 44 on "suction means" to apply force, as described by the Examiner in the Office Action of June 30, 2005, Dhawan teaches away from any orifice providing an open unsealed space of Claim 20, as such would be contrary to Dhawan's operation. Thus, Claim 20 and its dependent Claim 23 are patentable over the combination of the Corcuff Article, Dhawan, and Jester et al., and withdrawal of the rejection of Claims 20-23 is respectfully requested.

Claims 4, 5, and 7 were previously held allowed by the Examiner.

Claims 21 and 22 are allowable but objected to as being dependent on rejected claims. Applicant believes that dependent Claims 21 and 22 are allowable along with their base Claim 20.


Claims 49-51 have been added to the Application for consideration by the Examiner, and are believed patentable over the Corcuff article, Dhawan, and Jester et al.

This Amendment is being filed with a Request for Continued Examination (RCE) under 37 CFR 1.114, in which under 37 CFR 1.114(d) such RCE filing will be treated by the Patent

Office as withdrawal of Appeal. A check in the amount of \$175.00 for the additional claim fee is enclosed.

Respectfully submitted,

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Enclosures: Request for Continued Examination with a Check for \$395;  
Amendment Transmittal with check for \$175.00; and  
Certificate of Express Mail, Express Mail No. EV 586785531 US (RCE); and  
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Transmittal Letter).